

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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EXAMINER

ART. UNIT

PAPER NUMBER

8

DATE MAILED:

This is a communication from the examiner in charge of your application
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on

This action is **FINAL**

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Zero month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1 - 75 is/are pending in the application.
 Of the above, claim(s) _____ is/are withdrawn from consideration.
 Claim(s) _____ is/are allowed.
 Claim(s) _____ is/are rejected.
 Claim(s) _____ is/are objected to.
 Claims 1 - 75 are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
 The drawing(s) filed on _____ is/are objected to by the Examiner.
 The proposed drawing correction, filed on _____ is approved disapproved.
The specification is objected to by the Examiner.
The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____
received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

Interview Summary PTO 413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17, drawn to binding assays to identify inhibitors of binding between host and viral proteins, classified in class 435, subclass 5.
 - II. Claims 18-27, drawn to methods of treating influenza infection comprising administering inhibitors of binding between host and viral proteins, classified in class 514, subclass 12.
 - III. Claims 28-45, drawn to DNAs encoding NPI-1 through NPI-6 and NS1I-1 as well as vectors and host cells comprising them, classified in class 435, subclass 52.3.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I-III are patentably distinct from each other. The assays to identify inhibitors of Group I, the methods to treat infections with inhibitors of Group II, and the DNAs, vectors, and host cells of Group III do not require each other for their practice; have separate utilities, such as use of the Group I assays to identify inhibitors versus use of the Group II methods to treat disease versus use of the Group III products in methods of recombinant protein production; and are subject to separate manufacture and sale. The Groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

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3. Because these inventions are distinct for the reasons given above and the search required for any one Group is not required for any other Group, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

In Group I, Species A is represented by claim 3, drawn to assays with NPI-1; Species B is represented by claim 4, drawn to assays with NPI-2; Species C is represented by claim 5, drawn to assays with NPI-3; Species D is represented by claim 6, drawn to assays with NPI-4; Species E is represented by claim 7, drawn to assays with NPI-5; Species F is represented by claim 8, drawn to assays with NPI-6; and Species G is represented by claims 9 and 10, drawn to assays with NSII-1. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, and 11-17 are generic.

In Group II, Species H is represented by claim 19, drawn to assays with NP; Species I is represented by claim 20, drawn to assays with NPI-1; Species J is represented by claim 21, drawn to assays with NPI-2; Species K is represented by claim 22, drawn to assays with NPI-3; Species L is represented by claim 23, drawn to assays with NPI-4; Species M is represented by claim 24, drawn to assays with NPI-5; Species N is represented by claim 25, drawn to assays with NPI-6;

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Species O is represented by claim 26, drawn to assays with NS; and Species P is represented by claim 27, drawn to assays with NSII-1. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 18 is generic.

In Group III, Species Q is represented by claims 28-33, drawn to DNAs encoding NPI-1; Species R is represented by claims 34-39, drawn to DNAs encoding NPI-2; Species S is represented by claims 34-39, drawn to DNAs encoding NPI-3; Species T is represented by claims 34-39, drawn to DNAs encoding NPI-4;. Species U is represented by claims 34-39, drawn to DNAs encoding NPI-5; Species V is represented by claims 34-39, drawn to DNAs encoding NPI-6; Species W is represented by claims 40-45, drawn to DNAs encoding NSII-1. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 34-39 are generic only for Species R through V.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. A telephone call was made to Laura A. Coruzzi on August 24, 1996 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

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7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

11. Any inquiry concerning this communication or earlier communications should be directed to Kawai Lau whose telephone number is 703-308-4209. The examiner can normally be reached Monday-Friday from 7 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Wax, can be reached at 703-308-4216.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703-308-0196.

Certain papers related to this application may be submitted to Group 1800 by facsimile transmission to the attention of the examiner in Art Unit 1814. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (October 19, 1988) and 1157 OG 94 (December 28, 1993) (see 37 CFR § 1.6(d)). The FAX telephone number is 703-305-7401. Note: If applicants do submit a paper by facsimile, the original signed copy should be retained by applicants or applicants' representative. No duplicate copies should be submitted so as to avoid the processing of duplicate papers in the Office.

Kawai Lau, Ph.D.

August 13, 1996


ROBERT A. WAX
SUPERVISORY PATENT EXAMINER
GROUP 180